

**REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 141-143, 145-150, 152, 154 and 155 are pending in the present application. No claims have been added, amended or canceled by the present amendment.

Claims 141-143, 145, 146, 152 and 154 stand rejected under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement. Specifically, the failure to comply with the written description requirement is based on Applicant's (1) deletion of the word "magnetic" and "tape;" (2) the addition of "copy prevention based on the type of input signal," and (3) recording on anything other than a magnetic medium such as a "tape."

Applicant respectfully traverses this rejection for at least the following reasons.

A test for determining whether later claimed subject matter is supported by an earlier written description is whether the disclosure of the application "reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date." *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177,179 (Fed. Cir. 1985); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The specification must provide information that clearly allows persons having ordinary skill in the art to recognize that the Applicant invented the later claimed subject matter. *Vas-Cath*, 935 F.2d at 1563-64, 19 USPQ2d at 1117; *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). The written description requirement is satisfied by the Applicant's disclosure of "such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966. The written description must show that the Applicant invented each feature that is included as a claim limitation and the adequacy of the written description is measured from the face of the application. *New Railhead* 298 F.3d at 1296, 63 USPQ2d at 1847. Put another way, one skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims. *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002); *Waldemar Link, GmbH & Co. v. Osteonics CoEp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994).

The failure of the specification to specifically mention a limitation that later appears in the claims is not fatal when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented. *All Dental*, 309 F.3d at 779, 64 USPQ2d at 1948; *Eiselstein*, 52 F.3d at 1039, 34 USPQ2d at 1470. An identity of the language of the specification and the added claims is not required, identity of the subject matter of the claims and that which is described, is necessary. *New Railhead*, 298 F.3d at 1296, 63 USPQ2d at 1847.

With regard to the claims which do not recite "magnetic" and "tape," Applicant respectfully submits that Applicant's disclosed invention is clearly not limited to a magnetic tape. In this regard, Applicant notes that none of the original drawing figures of this application is limited to "magnetic" or "tape" or "magnetic tape" and those drawing figures clearly disclose the invention in terms of an audio and video signal transmitting process and an audio and video signal receiving/recording process, as does the sentence bridging columns 1 and 2 of U.S. Patent 5,689,559, i.e., the patent sought to be reissued.

Applicant respectfully submits that one of ordinary skill in the art fully realizes that the disclosed application is in terms of an audio and video signal transmitting process and an audio and video signal receiving/recording process, and does not require a magnetic recording medium or a tape medium.

Accordingly, the Office Action does not make out a *prima facie* case that the claimed invention fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 141-143 and 148-149 stand rejected under 35 U.S.C. § 112, second paragraph, because the language "determining a number of transport packets . . . when . . . minimum . . ." is unclear in that the meaning of the word "minimum" is unclear either in terms of number or time. This rejection is respectfully traversed.

The entire context of the clauses in issue is omitted from the rejection. The clauses in issue actually recite, among other things, "determining a number of transport packets, and when the processor determines the number of transport packets is a minimum of a multiple of four transport packets, the executable instructions further cause the processor to perform . . ." Thus, it is clear, that

the recited "minimum" is "a multiple of four transport packets." Support for this is found, for example, in Applicant's Fig. 3, as originally filed.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 141-143, 145, 146, 152 and 154 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roth et al. in view of Bourel. This rejection is respectfully traversed.

Amended independent claim 141 includes a combination of elements and is directed to an apparatus for processing digital data. The apparatus includes a processor; and a memory connected to the processor and including executable instructions that when executed by the processor, cause the processor to perform: receiving digital data including a plurality of transport packets having a header and a scrambled data unit; detecting a header of a first transport packet included in the plurality of transport packets; extracting a marker from the header of the first transport packet; extracting first control data from the extracted marker; descrambling, using the same first control data and the same descrambler, both scrambled digital video and audio data included in the scrambled data unit of the first transport packet and the scrambled digital video and audio data including in one or more succeeding scrambled data units in the transport packets following the first transport packet; and determining a number of transport packets that have been processed, and when the processor determines the number of transport packets is a minimum of a multiple of four transport packets, the executable instructions further cause the processor to perform detecting the header of a next transport packet included in the plurality of transport packets; extracting a marker from the header of the next transport packet; extracting second control data from the extracted marker; and descrambling, using the same second control data and the same descrambler, both scrambled digital video and audio data included in the scrambled data unit of the next transport packet and the scrambled digital video and audio data including in one or more succeeding scrambled data units in the transport packets following the next transport packet. Independent claim 150 includes similar features in a varying scope.

These features are supported at least by the non-limiting features as shown in Figures 2 and 3 and described in the corresponding description in the specification. For example, these Figures illustrate an apparatus for processing digital data. The apparatus includes a processor; and a memory connected to the processor and including executable instructions that when executed by the processor, cause the processor to perform: receiving digital data including a plurality of transport

packets having a header and a scrambled data unit (see the transport packets in Figure 3); detecting a header of a first transport packet included in the plurality of transport packets (reference numeral 11 in Figure 2); extracting a marker from the header of the first transport packet (numeral 11 in Figure 2 and see Figure 3); extracting first control data (CW1) from the extracted marker; descrambling 14, using the same first control data and the same descrambler, both scrambled digital video and audio data included in the scrambled data unit of the first transport packet and the scrambled digital video and audio data including in one or more succeeding scrambled data units in the transport packets following the first transport packet (see descrambling in Figure 3 for CW1); and determining a number of transport packets that have been processed, and when the processor determines the number of transport packets is a minimum of a multiple of four transport packets, the executable instructions further cause the processor to perform detecting the header of a next transport packet included in the plurality of transport packets; extracting a marker from the header of the next transport packet; extracting second control data from the extracted marker; and descrambling, using the same second control data and the same descrambler, both scrambled digital video and audio data included in the scrambled data unit of the next transport packet and the scrambled digital video and audio data including in one or more succeeding scrambled data units in the transport packets following the next transport packet (see CW2 being used for descrambling after a minimum of a multiple of four transport packets have been processed).

Roth is said to disclose "receiving digital data including a plurality of transport packets having a header and a scrambled data unit; detecting a header of a first transport packet included in the plurality of transport packets; extracting a marker from the header of the first transport packet; extracting first control data from the extracted marker in several different locations, including (1) Fig. 2; (2) col. 1, lines 57-60; (3) col. 2, lines 36-47 and 55-57; (4) col. 3, lines 2-4, and lines 30-38; (5) from col. 3, line 66 to col. 4, line 6; and (6) col. 4, lines 15-20.

Unfortunately, no specific elements of Fig. 2 or wording in those seven quoted passages is indicated which constitute these positively recited claimed features. In fact, Applicant respectfully submits the Office Action is leaving this to speculation, which is not a proper basis for a rejection under 35 U.S.C. § 103.

In addition to these shortcomings, Roth also, admittedly, does not disclose that the digital data includes both audio and video data or use of the same descrambler to descramble both the digital video

data and the digital audio data. Not only is there no explicit disclosure of this positively recited feature, but there is also no inherent disclosure thereof. In this regard, Applicant notes that inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In an attempt to remedy these admitted shortcomings of Roth, the Office Action turns to Bourel. Bourel, however, does not remedy all of the shortcomings of Roth.

For example, Bourel does not disclose using the same descrambler for its audio and video data. Specifically, Fig. 1 discloses a separate video descrambler 1 and audio descrambler 11, and Fig. 3 discloses a separate video descrambler 23 and audio descrambler 211. Additionally, Bourel clearly discloses that its video and sound parts are completely independent (col. 5, see the first sentence of the last full paragraph).

Additionally, Bourel, like Roth (as explained above) does not disclose the "a minimum of a multiple of four transport packets" feature.

Accordingly, no matter how one combines Roth and Bourel, there is no logical basis in either reference, and, therefore, in the combination thereof, to arrive at, suggest, or otherwise render obvious the claimed invention.

Applicant also (again) mentions that as discussed with SPE Mr. Hewitt, the applied art does not teach or suggest descrambling, using the same first control data and the same descrambler, both scrambled digital video data and audio data included in the scrambled data unit of the first transport packet and the scrambled digital video and audio data included in one or more succeeding scrambled data units in transport packets following the first transport packets as claimed by the present invention nor the additional feature of descrambling, using the same second control data and the same descrambler, both scrambled digital video and audio data included in the scrambled data unit of the next transport packet and the scrambled digital video and audio data included in one or more succeeding scrambled data units in the transport packets following the next transport packet as claimed by the present application.

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Thus, reconsideration and withdrawal of this rejection are respectfully requested.

**CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David A. Bilodeau (Reg. No. 42,325) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

Dated: June 15, 2011

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
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David A. Bilodeau, 42,325  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road, Suite 100 East  
P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment: APPENDIX A – LISTING OF ALL CLAIMS